

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Title : Novel Flow Cytometer  
Inventors : Glenn Spaulding  
Serial No : 09/550,276 § Examiner : Gailene Gabel  
Filed : 15 April 2000 § Phone : 571-272-0820  
Docket : 010-US-002 § Art Unit : 1641  
Customer : 29664

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF**

Pursuant to 37 C.F.R. 41.43(b), Appellant files this Reply Brief in response to the Examiner's Answer mailed 22 May 2006.

This Reply Brief is part of an appeal from the rejection of claims 1-4, 10, 11, 13-31, 33 and 34 in the Final Office Action dated 20 October 2004.

**REAL PARTY IN INTEREST**

The real party in interest in the above-referenced patent application is Spin Diagnostics, Inc., a Texas corporation.

**RELATED APPEALS AND INTERFERENCES**

To the present knowledge of Appellant's representative, there are currently no related appeal or interference proceedings that will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the present Appeal.

**STATUS OF CLAIMS**

In the Final Office Action dated 20 October 2004, claims 1-4, 10, 11, 13-31, 33 and 34 were rejected. Claims 5-9 were cancelled in response to two different restriction requirements issued by the Examiner. Claims 12 and 32 were cancelled by Appellant. Claims 1-4, 10, 11, 13-31, 33 and 34 are appealed.

**STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the Final Office Action dated 20 October 2004.

**SUMMARY OF THE CLAIMED INVENTION**

As acknowledged in the Examiner's Answer, Appellant's Summary of the Claimed Subject Matter is correctly stated in Appellant's Supplemental Appeal Brief. See Supplemental Appeal Brief at pages 5-8, filed 20 April 2006.

**GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Independent claims 1 and 10 and dependent claims 2, 11, 21, 22, 33 and 34 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,582,795 to Nishina et al.

Dependent claims 24, 25 and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nishina et al. in view of US Patent 5,352,879 to Milch.

Dependent claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nishina et al. in view of US Patent 5,126,554 to Izumi.

Dependent claims 3, 13-18, 26-28 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nishina et al. in view of US Patent 6,254,834 to Anderson et al.

Dependent claims 4, 19, 20 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nishina et al. in view of Anderson et al. and further in view of Surmodics, Inc.

### **Rejections Withdrawn**

Appellant acknowledges that in the Examiner's Answer, the rejection of claim 2 under 35 U.S.C. 112, ¶ 2 has been withdrawn. Examiner's Answer at page 3.

### **COMMENTS REGARDING THE EXAMINER'S STATEMENTS CONCERNING ALLOWABLE SUBJECT MATTER**

It is Appellant's belief that the plain language of the claims as they currently stand is semantically equivalent to that proposed by the Examiner. Accordingly, there appears to be no rational basis to make the requested change, especially in light of prevailing Federal Circuit precedent that vitiates virtually all of a patentee's equivalency rights during litigation for any amendments made in response to a substantive rejection. On this point, it is noted that it is not the Examiner's job to word-smith an Applicant's claims. All that is legally required is that the recited language distinguish the claimed invention from the prior art of record. 35 U.S.C. 112. Appellant believes this is clearly the case.

Appellant stands by its arguments regarding the Examiner's substantive rejections (*i.e.*, based on 35 U.S.C. 102 and 103) as provided in its Supplemental Appeal Brief dated 20 April 2006.

Respectfully submitted,

12 July 2006

Date

/Coe F. Miles/

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